

Claims 1-18 and 32-40 satisfy the requirements of 35 U.S.C. § 101

These claims stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Office Action states that the claims recite a series of steps that are grounded in the abstract ideas of, for example, providing, recording, calculating, etc. Thus, the Office Action alleges that the claims “do not provide sufficient computer structure,” citing *In re Toma*, 197 USPQ 852 (CCPA 1978). This 25 year old case involved claims reciting an algorithm, and is apparently cited for the outdated proposition that all claim elements must include subject matter must in the “technological arts.” However, this case and others like it were put into perspective by *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998), abruptly changed the way business method claims (and the like) are treated. In *State Street*, the Federal Circuit made clear that the so-called “business method” exception to statutory subject matter “merely represented the application of some general, but no longer applicable legal principle, perhaps arising out of the ‘requirement for invention’ which was eliminated by 35 U.S.C. § 103” and that “business methods should be subject to the same legal requirements for patentability as applied to any other process or method.” *Id.* Applicant respectfully submits that its claims represent methods of doing business, and therefore satisfy all requirements of 35 U.S.C. § 101.

The Office Action does suggest that “changes to fix this issue are relatively minor” and that the rejection could be overcome merely by adding “by a computer” to each of these claim elements. However, aside from those claims that specifically recite a step performed by a computer, and any claims reciting steps that may inherently require such limitation, the steps recited in its method claims were not necessarily intended to be limited to performance “by a computer.” In light of *State Street* and its progeny, Applicant respectfully submits that it is not necessary to add such limitations to its claims, in order to satisfy the requirements of 35 U.S.C. §

101. In view of the above, Applicant respectfully requests that the rejection of these claims under § 101 be reconsidered and withdrawn.

Claims 1-18 are not anticipated by Stonedahl

Claims 1-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Stonedahl, Publication No. US 2002/0199198 A1. Stonedahl was published December 26, 2002, and claims priority from Provisional Application No. 60/299,630, filed June 20, 2001, which is believed to be the effective date of the Stonedahl reference for purposes of 35 U.S.C. § 102(e). This effective priority date of June 20, 2001 pre-dates the filing date of the present application by several months. However, included with this response is a Declaration of Prior Invention to Overcome Cited Patent Under 37 C.F.R. § 1.131, which establishes conception of the invention prior to the effective date of Stonedahl coupled with the inventor's diligence from prior to said effective date to the filing of the present application. The enclosed Declaration is signed by the sole inventor of the present application, and is accompanied by a detailed memorandum, which describes the invention and supports all of the rejected claims. The Declaration is also accompanied by the Assignee's business plan and financial projections as well as other correspondence evidencing the inventor's diligence from a time prior to the effective date of the Stonedahl reference to the time the present application was filed.

It is respectfully submitted that this Declaration and its supporting documents establish conception of the invention prior to the effective date of the Stonedahl reference and the inventor's diligence from prior to said effective date to the filing of the present application. For these reasons, Applicant respectfully submits that the Stonedahl reference has been removed as possible prior art under § 102(e). Therefore, the rejection of Claims 1-18 in the present application based on the Stonedahl reference are believed to be moot.